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MAILED

AUG 10 2009

OFFICE OF PETITIONS

In re Application of :
Cleon Louis Griffiths :
Application Number: 09/825483 : ON PETITION
Filing Date: 04/03/2001 :
For: SECURE CONDOM :

This is a decision on the twice renewed petition under 37 CFR 1.137(a) filed on May 28, 2009, to revive the above-identified application.

The petition is again **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

The application became abandoned on November 23, 2002, for failure to timely file a proper response to the Office action stating that the prior reply appeared to be a *bona fide* attempt at a reply, but was insufficient, which set a one (1) month shortened statutory period for reply. A response was received on March 18, 2003, but was untimely. On November 5, 2003, an Office letter was mailed stating that the reply filed on March 18, 2003, was untimely, and that extensions of time were required. On November 18, 2003, Notice of Abandonment was mailed. A petition under 37 CFR 1.137(a) was filed on December 17, 2007. On January 18, 2008, the petition was dismissed. On March 10, 2009, a letter was filed, addressed to the undersigned Petitions Attorney, whereby petitioner *pro se* states that he wishes to provide additional information concerning the circumstances at the time the application was filed. In response, on March 19, 2009, a decision was mailed stating that the paper filed on March 10, 2009, was treated as a renewed petition under 37 CFR 1.137(a), and that the petition was again dismissed. An unsigned paper was filed on March 26, 2009. On May 6, 2009, a letter in response to the unsigned petition was mailed.

On May 28, 2009, the subject twice renewed petition was filed. Petitioner asserts that the delay in filing the required reply was due to the examiner informing applicant "that there was nothing patentable ... in violation of the Patent Office rule 35 USC 282 which states that the patent office personnel must not express any opinion about the patentability or unpatentability of any claim in any US patent."

STATUTE AND REGULATION

35 U.S.C. § 133 states that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

37 CFR 1.113 states in pertinent part that:

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objections to form.

37 CFR 1.135 states in pertinent part:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR 1.137(a) provides:

Unavoidable. Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a Nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in § 1.17(1);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

OPINION

The showing of record does not rise to the level of unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable," 35 U.S.C. § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.¹

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."² Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.³

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of

¹ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

³ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(a):

- (1) The delay in reply that originally resulted in abandonment;
- (2) The delay in filing an initial petition pursuant to § 1.137(a) to revive the application; and
- (3) The delay in filing a *grantable* petition pursuant to § 1.137(a) to revive the application.⁵

This petition lacks the showing required by periods (1), (2) and (3).

With regards to item (1) and (2), petitioner has provided no basis supporting a showing of unavoidable delay. The statements in the petition again appear to be simply petitioner's interpretation of communications with the examiner and an argument as to why the invention is patentable.

Accordingly, the showing of record is that the delay occurred because of petitioner's misunderstanding of the patent prosecution process. A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their

⁴ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁵ See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

A review of the record indicates that the delay in this case is due to petitioner's lack of awareness of USPTO rules and procedures.

As noted in MPEP 711.03(c):

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay.⁶ For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action... Finally, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from PTO employees; or (B) the PTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.⁷

In fact, it would appear that with respect to item (1), petitioner intentionally abandoned the application. See Petition filed March 26, 2009, page 1: which states "At this stage of the game, I figured that I would never get a patent, so I quite frankly gave up on the idea."

In this regard, it is noted that petitioner states that he did not file the required reply because he did not believe the invention was patentable. Petitioner states "The fact of the matter is that if [the examiner] had not told me there was nothing patentable, I would have sent in [the required reply]."

⁶ See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

⁷ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

The showing of record does not suggest a finding of unavoidable delay, as petitioner clearly did not comply by 37 CFR 1.135 by diligently prosecuting the application to avoid abandonment. Rather, petitioner's statement suggests that petitioner decided to abandon prosecution of the application because petitioner had concluded that further prosecution would be fruitless. Such a showing suggests that the delay was not unavoidable, but was intentional. As stated in MPEP 711.03(c), where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b).⁸ In this regard petitioner, not the Office, is responsible for the prosecution of petitioner's patent application.

As stated in MPEP 711.03(c), a delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;
- (C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;
- (D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or
- (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

⁸ See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989).

In the petition filed on May 28, 2009, petitioner states that he "pretty well (sic) gave up on ever getting a Patent since the person who could patent it decided that there was nothing patentable." Petitioner further states that after he visited his brother, he decided once again to pursue a patent in this application. For this reason, the showing of record is that the delay resulted not from unavoidable delay, but from a change in circumstances.

MPEP 711.03(c) states, in pertinent part, that a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

With regards to item (3), above, petitioner has not explained the lengthy delay in responding to the petition filed on January 18, 2008, which set a two (2)-month shortened period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained, and a renewed petition was not filed until March 10, 2009, over a year later. In the decision of March 19, 2009, petitioner was asked to explain why this period of delay should be considered as unavoidable, but no explanation has been provided. Rather, petitioner has presented several petitions and papers, dated December 17, 2007, March 10, 2009, March 26, 2009, and May 28, 2009, all arguing essentially that the delay was due to the actions of the examiner.

As stated *supra*, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.

Further, in regards to petitioner's assertion that the examiner improperly stated that "there was nothing patentable in my application," MPEP 1701 states that, in pertinent part, that public policy demands that every employee of the United States Patent and Trademark Office (USPTO) refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent. (emphasis added). See also 35 U.S.C. 282.

In this regard, petitioner is confusing an issued patent with an application for patent. While every patent is presumed to be valid,⁹ and Office personnel may not express an opinion to the validity or invalidity of a U.S. patent, no U.S. patent has been issued in this application. Rather, an examiner must examine the application and make a determination as whether or not the applicant is entitled to patent. To this end, 35 USC 101 specifies what inventions are patentable, and 35 U.S.C. 102 and 103 stipulate the conditions for patentability. 35 USC 131 states that the Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

Accordingly, the showing of record is that applicant delayed filing a renewed petition because of petitioner's misunderstanding of the rules, laws, and procedures concerning practice before the Office. As such, the showing of record is that the delay was not unavoidable.

In summary, this application cannot be revived under either 37 CFR 1.137(a) or (b) because of applicant's intentional delay.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

⁹ 35 U.S.C. 282 (first sentence).

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.

A handwritten signature in black ink, appearing to read "D Wood", with a long, sweeping horizontal stroke extending to the right.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions